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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/791,727	03/04/2004	Kia Silverbrook	ZE027US	6827
24011	7590	07/30/2004	EXAMINER	
SILVERBROOK RESEARCH PTY LTD			MAYES, MELVIN C	
393 DARLING STREET			ART UNIT	PAPER NUMBER
BALMAIN, 2041				1734
AUSTRALIA				

DATE MAILED: 07/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/791,727	SILVERBROOK, KIA
	<b>Examiner</b>	<b>Art Unit</b>
	Melvin Curtis Mayes	1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1,4-6 and 8 is/are rejected.
- 7) Claim(s) 2,3 and 7 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \*    c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. 09/721,856.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 3/4/04.
- 4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

(1)

The disclosure is objected to because of the following informalities: continuity data is missing from page one. Application 10/126,676 is a continuation of Application 09/721,856.

Appropriate correction is required.

### ***Double Patenting***

(2)

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

(3)

Claims 1, 4-6 and 8 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12 and 13 of U.S. Patent No. 6,530,339 in view of GB 2 303 580 and Minami 5,601,389.

U.S. Patent No. 6,530,339 claims an apparatus comprising: a page conveying path for conveying pages; a print head for printing on pages moving along the path; an two adhesive

applicators, one on each side of the path, with one adapted for applying one part of a two-part adhesive to one side of each page and the other adapted for applying the other part of the two-part adhesive to the other side of each page.

GB 2 303 580 teaches that an apparatus for gluing together sheets has a frame for receiving and stacking the sheets after gluing, the frame mounted on vertical rods for movement and having a floor for supporting the stack of sheets and an end stop in the form of a wall to arrest further movement of the sheets and towards which the sheets are knocked to ensure even stacking (Abstract, pg. 4, lines 10-25).

Minami teaches that an apparatus for binding sheets by glue has a pressing plate associated with the storage portion for pressing the glue-attached portions of the sheets (col. 3, lines 8-15).

It would have been obvious to one of ordinary skill in the art to have modified the apparatus of U.S. Patent No. 6,530,339 by providing a frame (tray) mounted on rods (frame) and having a floor and end wall, as taught by GB 2 303 580 to provide a frame for receiving and stacking the sheets after gluing, the floor for supporting the stack of sheets and the end wall to arrest further movement of the sheets and towards which the sheets are knocked to ensure even stacking.

It would have been obvious to one of ordinary skill in the art to have further modified the apparatus of U.S. Patent No. 6,530,339 by providing a pressing plate (binding mechanism), as taught by Minami, for pressing the glue-attached portions of the sheets.

(4)

Claims 1, 4-6 and 8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of copending Application No. 2003/0062132 in view of GB 2 303 580 and Minami 5,601,389.

Copending Application No. 2003/0062132 claims an apparatus comprising: a conveyor including a pair of pinch roller that coveys a page along a paper path; a print head located after the pinch rollers; first and second adhesive applicators located after the print head to apply first and second parts of two-part adhesive to opposite sides of the page; and a support for placement of the pages.

GB 2 303 580 teaches that an apparatus for gluing together sheets has a frame for receiving and stacking the sheets after gluing, the frame mounted on vertical rods for movement and having a floor for supporting the stack of sheets and an end stop in the form of a wall to arrest further movement of the sheets and towards which the sheets are knocked to ensure even stacking (Abstract, pg. 4, lines 10-25).

Minami teaches that an apparatus for binding sheets by glue has a pressing plate associated with the storage portion for pressing the glue-attached portions of the sheets (col. 3, lines 8-15).

It would have been obvious to one of ordinary skill in the art to have modified the apparatus of copending Application No. 2003/0062132 by providing the support for placement of the pages as a frame (tray) mounted on rods (frame) and having a floor and end wall, as taught by GB 2 303 580, to provide a support for receiving and stacking the sheets after gluing, the

floor for supporting the stack of sheets and the end wall to arrest further movement of the sheets and towards which the sheets are knocked to ensure even stacking.

It would have been obvious to one of ordinary skill in the art to have further modified the apparatus of copending Application No. 2003/0062132 by providing a pressing plate (binding mechanism), as taught by Minami, for pressing the glue-attached portions of the sheets.

This is a provisional obviousness-type double patenting rejection.

***Allowable Subject Matter***

(5)

Claim 2, 3 and 7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

(6)

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(7)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melvin Curtis Mayes whose telephone number is 571-272-1234. The examiner can normally be reached on Mon-Fri 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached on 571-272-1187. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Melvin Curtis Mayes  
Primary Examiner  
Art Unit 1734

MCM  
July 27, 2004